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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/639,613	08/11/2003	Minyu Li	163.1321USC2 (ECO0007/US/	5398
70959	7590	08/06/2007	EXAMINER	
KAGAN BINDER, PLLC SUITE 200, MAPLE ISLAND BUILDING 221 MAIN STREET NORTH STILLWATER, MN 55082			GOLOBOY, JAMES C	
			ART UNIT	PAPER NUMBER
			1714	
			MAIL DATE	DELIVERY MODE
			08/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/639,613

Applicant(s)

LI ET AL.

Examiner

James Goloboy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-17,19,20 and 74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-17, 19-20, 74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Please note the new examiner of record.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/24/07 has been entered.

***Priority***

3. The claims as currently filed are entitled to a filing date of June 16, 2000, as "emulsion lubricant" is supported by application 09/595,835, which was filed on that day. The examiner noted that the filing date of this application has been written incorrectly in the specification, as discussed in paragraph 2 below. Based on this priority date and applicant's statement of common ownership, the rejections set forth in the office action mailed 6/21/06 are overcome except for that set forth in paragraph 6 below.

***Specification***

4. The disclosure is objected to because of the following informalities: Page 1 of the specification, as currently amended, claims priority to application 09/595,835, filed on June 16, 2002. However, the application was filed in 2000, not 2002.

Appropriate correction is required.

***Double Patenting***

5. Claims 1, 4-17, 19-20, and 74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-70 of U.S. Patent No. 6,427,826 to Li. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 1 of the '826 patent discloses a method comprising forming a continuous thin film of a liquid lubricant composition, comprising about 5 to 50% by weight of an aqueous phase, in an amount of about  $2 \times 10^{-4}$  to 0.05 grams of lubricant per square inch of surface, and in an amount sufficient to provide lubricating properties up to about 5 mm. The method further comprises moving a container on the conveyor surface.

Claim 2 of the '826 patent discloses that the lubricant is an emulsion, and claim 25 of the '826 patent discloses that the oil phase can comprise silicone. Claim 18 of the '826 patent disclose that the lubricant is placed on the surface of the moving conveyor to leave a lubricated area and unlubricated margin. Claims 4-17 and 19-20 of the '826 patent are analogous to claims 4-17 and 19-20 of the current application. The '826 patent therefore discloses all the limitations of the current claims 1 and 4-17 and 19-20.

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The difference between the '826 patent and the current claim 74 is that while claim 28 of the '826 patent discloses that the composition can contain a surfactant, the claims of the '826 patent do not disclose a silicone surfactant.

Applicant's attention is drawn to M.P.E.P. § 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F. 2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F. 2d 438, 164 USPQ 619, 622 (CCPA 1970). In this case, it would have been obvious to one of ordinary skill in the art to use a silicone as the surfactant of claim 28, as column 4 lines 29-30 and column 5 lines 58-59 of the '826 patent teach that silicone surfactants are useful as additives in the lubricating composition.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 4-17, 19-20, and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Person Hei (U.S. Pat. No. 6,673,753).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Person Hei is a continuation of application no. 09/441,881 and therefore has an effective filing date of November 17, 1999, qualifying it as prior art under 35 USC 102(e).

Person Hei, in the reference's claim 36-52, discloses a method of lubricating the interface between a container and a moving container surface meeting all the limitations of the current claims except for the use of a silicone oil and a silicone surfactant. In column 4 line 18 Person Hei teaches that the oil can be a silicone oil, as recited in claim 1, and in column 11 lines 33-34 and 54-58 teaches that the composition can further comprise silicone surfactants, meeting the limitations of claim 74. Therefore, the method of claims 1, 4-17, 19-20, and 74 is clearly anticipated by Person Hei.

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8. Claims 1, 4-5, 10-11, and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Li (U.S. Pat. No. 6,288,012)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Li, in the reference's claims 2 and 5, discloses a method for lubricating a container conveyor, comprising applying a "substantially non-aqueous" lubricant to a contact surface of a conveyor. In column 3 line 9, Li teaches that the "substantially non-aqueous" lubricant can contain less than 5% by weight of water, with the endpoint of the range matching the "about 5%" endpoint of the range recited in claim 1(a). When water is present, the composition is a liquid emulsion, as recited in claim 1(a). In column 3 lines 28-29, Li teaches that the oil phase of the composition can contain a silicone surfactant, as recited in claims 1(a) and 74. The reference's claim 2 teaches that the lubricant is applied to "at least a portion" of the contact surface. It is the examiner's position that when the lubricant is applied to a portion of the contact surface, a lubricated area and an unlubricated margin are formed, as in claim 1(a). In column 2 lines 40-43, Li further teaches that the method also includes moving containers on the conveyor, meeting the limitations of claim 1(b). In light of the above, the method of claims 1 and 74 are anticipated by Li.

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Li additionally teaches in column 3 lines 39-46 that the composition can contain a suspension of a solid, meeting claim 4, and in column 5 line 40 that the lubricant can be used on aluminum cans, as in claim 5. It is further noted, that the emulsion must be either stable or unstable to phase separation, and therefore at least one of claims 10-11 are anticipated by Li.

### ***Response to Arguments***

9. Applicant has argued that the reference applied in paragraph 7 above does not disclose the presently claimed method, but has not given any reasoning to support this position. The rejections are therefore maintained for the reasons set forth above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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